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EXAMINER

BLAKE, CAROLYN T

ART UNIT PAPER NUMBER

3724

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/645,371

Applicant(s)

SERVER, BRIDGETTE

Examiner

Carolyn T. Blake

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-20, 22-37 and 40-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-20, 22-37 and 40-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to applicant's amendment received on June 22, 2005.
2. The objection to the drawings is withdrawn in view of the amendment.
3. The objection to the specification is withdrawn in view of the amendment.
4. The objection to claims 37 is withdrawn in view of the amendment.
5. The text of those sections in Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

6. Claims 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (3,327,516) in view of Schiller (4,924,576), Gilmore (4,649,733), and McGill (67,665).

Regarding claim 18, Anderson discloses a method for fastening comprising the steps of: a) attaching an interchangeable punching tip (FIG 7 or FIG 8) to an elongate body (10) and forming holes in at least two mediums by striking an upper impact end of the elongate body (10) (see col. 1, lines 9-12), c) disposing a securing device through a hole in a medium; d) removing the punching tip (FIG 7 or FIG 8) from the elongate body (10); e) attaching an interchangeable setting tip (FIG 5 or FIG 6) to the elongate body (10) and placing the setting tip against a top of the securing g device; and f) striking the upper impact end of the elongate body.

Anderson fails to disclose threadably attaching and removing the tips. Schiller discloses threadably attaching an interchangeable tip (25) to an elongate

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body. The Schiller threaded connected would be more stable than the Anderson magnetic connection. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide threaded tips, as disclosed by Quiring, on the Anderson device for the purpose of stably securing the tip to the body.

Furthermore, Anderson fails to disclose using the method for fastening two mediums together. Gilmore discloses a method of fastening two mediums comprising the steps of: a) forming corresponding holes in the at least two mediums; b) aligning the holes in the at least two mediums (inherent); c) disposing a securing device through the holes in the at least two mediums; e) placing a setting tip against a top of the securing device; and f) striking an upper impact end of the elongate body attached to the setting tip to deform the top of the securing device. See col. 1, lines 17-22. This method is capable of easily securing two mediums. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use two mediums, as disclosed by Gilmore, with the Anderson method for the purpose of easily securing the mediums.

In addition, Anderson fails to disclose the at least two mediums being selected from the group consisting of scrapbook pages, photo album pages, photos, and decorative paper. However, McGill discloses a method for fastening at least two mediums substantially as claimed, wherein the two mediums are paper (col. 1, lines 6-8). Using the method with paper would allow for a variety of applications, such as creating notebooks. Therefore, it would have been obvious

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to one of ordinary skill in the art at the time the invention was made to use paper, as disclosed by McGill with the Anderson method for the purposes of creating a notebook.

Regarding claim 22, Anderson discloses the securing device is a rivet (FIG 6).

Regarding claim 24, Schiller discloses the tip (25) is threadably attached to an attachment end of the elongate body via mating screw threads on the attachment end of the body (20') and on the tip, the respective mating screw threads being configured to enable selective, threadable coupling of the setting tip to the body.

Regarding claim 25, Schiller discloses a shoulder formed on the tip (25), having a shape configured to facilitate attachment to and removal from the attachment end of the body.

Regarding claim 26, Schiller discloses the shoulder has a shape selected from the group consisting of hexagonal and octagonal.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Schiller, Gilmore, and McGill as applied to claims 18, above, and further in view of Schofield (373,201). The Anderson-Schiller-Gilmore-McGill combination fails to disclose a setting tip with a raised pattern. However, Schofield discloses placing a setting tip with a raised pattern (D) against the top of the securing device (A/B); and wherein the step of striking sets the securing device (A/B) and creates a corresponding pattern of the raised pattern on the recurring device. Schofield discloses the pattern on the securing device is used

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for identification purposes (col. 3, line 56 to col. 4, line 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a pattern on the securing device, as disclosed by Schofield, with the Anderson-Schiller-Gilmore-McGill method for the purpose of identifying the securing device.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Schiller, Gilmore, and McGill as applied to claim 18 above, and further in view of Olsen (1,887,360). The Anderson-Schiller-Gilmore-McGill combination fails to disclose an ejection chute. However, Olsen discloses a tool with an elongate body (10) including an ejection chute (15), formed in the body, and being configured to allow media punched by the punching tip (18/19) to be ejected out of the elongate body (10). See col. 1, lines 47-51. The ejection chute prevents the punched media from being clogged in the elongate body. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an ejection chute, as disclosed by Olsen, on the Anderson-Schiller-Gilmore-McGill combination for the purpose of preventing the punched media from being clogged in the elongate body.

9. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Schiller, Gilmore, and McGill as applied to claim 18 above, and further in view of Quiring (4,355,466). The Anderson-Schiller-Gilmore-McGill combination fails to disclose a knurled grasping portion. However, Quiring discloses a knurled grasping portion (12) disposed on the elongate body (10) near the impact end (11) of the elongate body (12). The knurling allows for ease

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of grasping by hand (col. 2, lines 11-12). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a knurled grasping portion (12), as disclosed by Quiring, on the Anderson-Schiller-Gilmore-McGill combination for the purpose of easily grasping the device by hand.

10. Claims 28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore in view of McGill and Schofield.

Regarding claim 28, Gilmore discloses a method for fastening at least two mediums of a scrapbook or photo album, comprising the steps of: a) forming corresponding holes in the at least two mediums; b) aligning the holes in the at least two mediums (inherent); c) disposing a securing device through the holes in the at least two mediums; d) placing a setting tip against a top of the securing device; and e) striking an upper impact end of the elongate body attached to the setting tip to deform the top of the securing device. See col. 1, lines 17-22. Gilmore fails to disclose the at least two mediums being selected from the group consisting of scrapbook pages, photo album pages, photos, and decorative paper. However, McGill discloses a method for fastening at least two mediums substantially as claimed, wherein the two mediums are paper (col. 1, lines 6-8). Using the method with paper would allow for a variety of applications, such as creating notebooks. In addition, McGill fails to disclose a setting tip with a raised pattern. However, Schofield discloses placing a setting tip with a raised pattern (D) against the top of the securing device (A/B); and wherein the step of striking sets the securing device (A/B) and creates a corresponding pattern of the raised

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pattern on the recurring device. Schofield discloses the pattern on the securing device is used for identification purposes (col. 3, line 56 to col. 4, line 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use paper, as disclosed by McGill, and to provide a pattern on the securing device, as disclosed by Schofield, with the Gilmore method for the purposes of creating a notebook and identifying the securing device.

Regarding claim 31, Gilmore discloses the securing device is a rivet (col. 1, line 18).

11. Claims 29 and 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore in view of McGill and Schofield as applied to claim 28 above, and further in view of Quiring.

Regarding claim 29, the Gilmore-McGill-Schofield combination fails to disclose a specific method of forming holes. However, Quiring discloses a step of forming corresponding holes includes: placing a punching tip (21) against at least one of the mediums; and striking an upper impact end (11) of an elongate body (10) attached to the punching tip (21) to drive the punching tip (21) through the at least one medium. This method is simplistic in both the steps and the device necessary to perform the operation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form holes by a punching tip, as disclosed by Quiring, with the Gilmore-McGill-Schofield combination due to the simplicity of the steps and device necessary to perform the operation.



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Regarding claim 36, the Gilmore-McGill-Schofield combination fails to disclose a knurled grasping portion. However, Quiring discloses a knurled grasping portion (12) disposed on the elongate body (10) near the impact end (11) of the elongate body (12). The knurling allows for ease of grasping by hand (col. 2, lines 11-12). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a knurled grasping portion (12), as disclosed by Quiring, on the Gilmore-McGill-Schofield combination for the purpose of easily grasping the device by hand.

12. Claims 30 is rejected under 35 U.S.C. 103(a) as being unpatentable Gilmore in view of McGill and Schofield as applied to claim 28 above, and further in view of Quiring and Anderson. The Gilmore-McGill-Schofield combination fails to disclose the method of forming holes and setting the securing device as claimed. However, Quiring discloses a method comprising the steps of: attaching an interchangeable punching tip (21) to an elongate body (10) prior to forming the holes in the mediums; and removing the punching tip (21) from the elongate body (10) prior to forming the holes in the mediums. This method is simplistic in both the steps and the device necessary to perform the operation. Quiring fails to disclose attaching the setting tip to the elongate body prior to placing the setting tip against the top of the securing device. However, Anderson discloses a punch and fastener setter wherein the punching tip (FIG 7) is attached to the elongate body (10) prior to forming holes, the punching tip (FIG 7) is removed from the body (10) after forming the holes in the mediums, and the setting tip (FIG 5 or FIG 6) is attached to the elongate body (10) prior to placing

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the setting tip (FIG 5 or FIG 6) against the top of the securing device. The multiple tips on the same body allow the user to choose the best tip for each operation while eliminating the need for several large tools. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form holes by a punching tip, as disclosed by Quiring, and provide multiple tool tips, as disclosed by Anderson, on the Gilmore-McGill-Schofield combination for the purpose of simplicity of the steps and device and using the best tip for each operation.

13. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore in view of McGill, Schofield, and Quiring as applied to claim 29 above, and further in view of Olsen. The Gilmore-McGill-Schofield-Quiring combination fails to disclose an ejection chute. However, Olsen discloses a tool with an elongate body (10) including an ejection chute (15), formed in the body, and being configured to allow media punched by the punching tip (18/19) to be ejected out of the elongate body (10). See col. 1, lines 47-51. The ejection chute prevents the punched media from being clogged in the elongate body. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an ejection chute, as disclosed by Olsen, on the Gilmore-McGill-Schofield-Quiring combination for the purpose of preventing the punched media from being clogged in the elongate body.

14. Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore in view of McGill and Schofield as applied to claim 28 above, and further in view of Anderson and Schiller.

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Regarding claim 33, the Gilmore-McGill-Schofield combination fails to disclose the setting tip is threadably attached to the elongate body. Anderson discloses a tool wherein the setting tip (FIG 5) is removably attached to the elongate body (10). This allows different tips to be attached to the body. Anderson fails to disclose the tip is threadably attached. However, Schiller discloses a tool wherein the tip (25) is threadably attached to an attachment end of the elongate body via mating screw threads (20') on the attachment end of the body and the tip, the respective mating screw threads being configured to enable selective, threadable coupling of the tip (25) to the body. The Schiller threaded connection would be more stable than the Anderson magnetic connection. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a removably attached setting tip, as disclosed by Anderson, wherein the connection is threaded, as disclosed by Schiller, on the Gilmore-McGill-Schofield combination for the purpose of stably securing the setting tip to the body with the potential to change the tip.

Regarding claim 34, Schiller discloses a shoulder formed on the tip (21), having a shape configured to facilitate attachment to and removal from the attachment end of the body.

Regarding claim 35, Schiller discloses the shoulder has a hexagonal shape.

15. Claims 37, 40, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Schiller, Gilmore, McGill, and Schofield.

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Regarding claim 37, Anderson discloses a method for fastening comprising the steps of: a) forming corresponding holes in a medium by placing a punching tip (FIG 7 or FIG 8) against a medium and striking an upper impact end of an elongate body (10) attached to the punching tip to drive the punching tip through the at least one medium; c) disposing a securing device through the hole in the medium; d) removing the punching tip from the elongate body (10) and attaching a setting tip (FIG 5 or FIG 6) to the elongate body (10); e) placing the setting tip against a top of the securing device; and f) striking an upper impact end of the elongate body (10) attached to the setting tip to deform the top of the securing device.

Anderson fails to disclose threadably attaching and removing the tips. Schiller discloses threadably attaching an interchangeable tip (25) to an elongate body. The Schiller threaded connection would be more stable than the Anderson magnetic connection. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide threaded tips, as disclosed by Quiring, on the Anderson device for the purpose of stably securing the tip to the body.

Furthermore, Anderson fails to disclose using the method for fastening two mediums together. Gilmore discloses a method of fastening two mediums comprising the steps of: a) forming corresponding holes in the at least two mediums; b) aligning the holes in the at least two mediums (inherent); c) disposing a securing device through the holes in the at least two mediums; e) placing a setting tip against a top of the securing device; and f) striking an upper

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impact end of the elongate body attached to the setting tip to deform the top of the securing device. See col. 1, lines 17-22. This method is capable of easily securing two mediums. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use two mediums, as disclosed by Gilmore, with the Anderson method for the purpose of easily securing the mediums.

Anderson fails to disclose the at least two mediums being selected from the group consisting of scrapbook pages, photo album pages, photos, and decorative paper. However, McGill discloses a method for fastening at least two mediums substantially as claimed, wherein the two mediums are paper (col. 1, lines 6-8). Using the method with paper would allow for a variety of applications, such as creating notebooks. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use paper, as disclosed by McGill with the Anderson method for the purposes of creating a notebook.

In addition, Anderson fails to disclose a setting tip with a raised pattern. However, Schofield discloses placing a setting tip with a raised pattern (D) against the top of the securing device (A/B); and wherein the step of striking sets the securing device (A/B) and creates a corresponding pattern of the raised pattern on the recurring device. Schofield discloses the pattern on the securing device is used for identification purposes (col. 3, line 56 to col. 4, line 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a pattern on the securing device, as

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disclosed by Schofield, with the Anderson method for the purpose of identifying the securing device.

Regarding claim 40, Anderson discloses the securing device is selected from the group consisting of an eyelet, a rivet, or a grommet.

Regarding claim 42, Schiller discloses the setting tip (25) is threadably attached to an attachment end of the elongate body via mating screw threads (20') on the attachment end of the body and on the setting tip, the respective mating screw threads being configured to enable selective, threadably coupling of the setting tip (25) to the body.

Regarding claim 43, Schiller discloses a shoulder formed on the setting tip (25), having a shape configured to facilitate attachment to and removal from the attachment end of the body.

Regarding claim 44, Schiller discloses the shoulder has a shape selected from the group consisting of hexagonal and octagonal.

16. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Schiller, Gilmore, McGill, and Schofield as applied to claim 37 above, and further in view of Olsen. The Anderson-Schiller-Gilmore-McGill combination fails to disclose an ejection chute. However, Olsen discloses a tool with an elongate body (10) including an ejection chute (15), formed in the body, and being configured to allow media punched by the punching tip (18/19) to be ejected out of the elongate body (10). See col. 1, lines 47-51. The ejection chute prevents the punched media from being clogged in the elongate body. Therefore, it would have been obvious to one of ordinary skill in the art at the

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time the invention was made to provide an ejection chute, as disclosed by Olsen, on the Anderson-Schiller-Gilmore-McGill combination for the purpose of preventing the punched media from being clogged in the elongate body.

17. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Schiller, Gilmore, McGill, and Schofield as applied to claim 37 above, and further in view of Olsen, and further in view of Quiring. The Anderson-Schiller-Gilmore-McGill-Schofield combination fails to disclose a knurled grasping portion. However, Quiring discloses a knurled grasping portion (12) disposed on the elongate body (10) near the impact end (11) of the elongate body (12). The knurling allows for ease of grasping by hand (col. 2, lines 11-12). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a knurled grasping portion (12), as disclosed by Quiring, on the Anderson-Schiller-Gilmore-McGill-Schofield combination for the purpose of easily grasping the device by hand.

### ***Response to Arguments***

18. Applicant's arguments, see the amendment filed June 22, 2005, with respect to the rejection(s) of claim(s) based on the Quiring reference have been fully considered and are persuasive. The Examiner agrees the Quiring does not teach threadably attaching a tip as claimed. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.

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***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

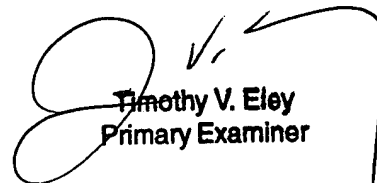
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CB

August 25, 2005



Timothy V. Eley  
Primary Examiner